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Mailed: 26 JUN 2003
Paper No. 10
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re United Coatings

Serial No. 76/233,386

Mark W. Hendricksen of Wells St. John P.S. for United Coatings.

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Before Simms, Walters and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 30, 2001, United Coatings (applicant) applied to register the mark ROOF MATE (in typed form) on the Principal Register for goods ultimately identified as "acrylic elastomer coating fluid applied roofing membrane; exterior paint; paint primer" in International Class 2.¹

¹ Serial No. 76/233,386. The application contains an allegation of a date of first use and a date of first use in commerce of December 31, 1983. In its reply brief (p. 1), applicant has agreed to disclaim the word "Roof."

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark ROOFMATE, in typed form, for "roof insulation" in International Class 19.² When the refusal was made final, this appeal followed.

The examining attorney argues that "the only difference between the marks is a space between the two word elements ROOF and MATE in applicant's mark." Brief at 6. The examining attorney also found that the goods are highly related and that the channels of trade are the same. These factors lead the examining attorney to conclude that there was a likelihood of confusion under Section 2(d).

Applicant does not seriously dispute the factors that the marks are similar and that the goods are related, but applicant instead argues that the lack of actual confusion demonstrates that confusion is not likely.

In many trademark applications and trademark litigation, the court or trier of fact is left with the speculative decision of whether there is likely to be confusion, based upon numerous factors that may be considered. In cases such as this however, where there are **eighteen years of concurrent use**, that speculation is removed and the mere fact of eighteen years concurrent use without any known instances of actual confusion and without any protest or issues

² Registration No. 728,153 issued March 6, 1962. Office records show that the registration was renewed for a second time on April 2, 2002.

raised by the prior registrant, removes the speculation and conclusively shows that there is no likelihood of confusion or actual confusion.

Applicant's Brief at 3 (emphasis in original).

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin our analysis by looking at the similarities and dissimilarities of the marks in the application and registration. The marks are identical except for the fact that applicant's mark includes a space while registrant's mark is spelled as one word. The absence of the space does not significantly change the appearance of the marks. Stockpot, Inc. v. Stock Pot Restaurant, Inc., 220 USPQ 52, 54 (TTAB 1983), aff'd, 737 F.2d 1576, 222 USPQ 665 (Fed.

Cir. 1984) ("There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical"); In re Best Western Family Steak House, Inc., 222 USPQ 827, 827 (TTAB 1984) ("There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical"). In addition, the marks would be pronounced identically, and their meanings and commercial impressions would be virtually the same, if not identical. The near-identical nature of the marks is a significant factor in the likelihood of confusion analysis. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("Without a doubt the word portion of the two marks are identical, have the same connotation, and give the same commercial impression. The identity of the words, connotation, and commercial impression weighs heavily against the applicant").

Regarding the goods, they are, at the very least, related. "In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that

they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

In this case, we find that, at the very least, there is some relation between the goods of applicant and registrant. Applicant's goods are a type of roofing membrane, exterior paint and paint primer while registrant's goods are roofing insulation. In its specimens, applicant indicates that: "Superior weatherability, ultraviolet resistance, fire retardancy, elongation, flexibility, adhesion, and ease of application make the ROOF MATE system an excellent protective elastomeric barrier for extending the life of most roofing substrates." Registrant's goods are roofing insulation. From the identification of goods and applicant's specimens, it is clear that applicant's roofing membrane and registrant's roofing insulation would be used together in maintaining, repairing, or constructing roofs to make them more effective.

The examining attorney has introduced some evidence that shows that roofing and insulation products are registered by the same entity under a common mark. See, e.g., Registration No. 2,390,161 (insulating products and

roofing membranes); No. 1,815,592 (asphalt roofing cement and fiberboard edge strips for use in conjunction with roof insulation); and No. 2,357,876 (insulation and roofing shingles).³ These registrations add additional support for the finding that roofing membranes and roofing insulation are related. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

We also have no basis to hold that the channels of trade and the purchasers of these products would not be similar if not overlapping. Potential purchasers interested in fixing or constructing a roof would often be interested in a barrier that extends the life of the roof as well as an insulating barrier that prevents heating or cooling loss. Even if we assume that the purchasers for

³ We have not considered the numerous registrations that are not based on use in commerce. Similarly, we do not find that several other registrations that contain an identification of goods for a single product that happens to use the terms "roofing" and "insulation" to be relevant.

these products are sophisticated, they are still subject to being confused when virtually identical marks are used on roofing insulation and roofing membranes. In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999) ("We recognize applicant's attorney's point that its software is expensive and that purchasers of it are likely to be sophisticated. Suffice it to say that no evidence in support of these assertions was submitted. In any event, even careful purchasers are not immune from source confusion").

Therefore, we conclude that when the marks ROOF MATE for acrylic elastomer coating fluid applied roofing membrane, exterior paint, and paint primer and ROOFMATE for roofing insulation are used by different parties, there is a likelihood of confusion.

To rebut the examining attorney's holding that there is a likelihood of confusion, applicant's primary, if not exclusive, argument as we indicated earlier is its assertion that there has been no actual confusion for eighteen years. We do not find this argument persuasive for several reasons. First, this assertion is simply argument of counsel unsupported by any evidence. Second, applicant has submitted no evidence in this case so there is no indication of the nature and extent of how applicant

has marketed its product. Third, unlike the cases that applicant cites, this is an ex parte proceeding and registrant has not had an opportunity to contradict applicant's statement. The Federal Circuit has recently addressed the question of the weight to given to an assertion of no actual confusion by an applicant in an ex parte proceeding.

With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See In re Bissett-Berman Corp., 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, J.C. Hall Co. v. Hallmark Cards, Inc., 52 C.C.P.A. 981, 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965), especially in an ex parte context.

Majestic Distilling, 65 USPQ2d at 1205.

We also note that even in inter partes cases, the lack of actual confusion does not compel a conclusion that there is no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). When the marks are virtually identical and the

goods are roofing insulation and membranes, the unsupported statement of applicant's attorney that there is no evidence of actual confusion carries little weight. Finally, we add that "this is a proceeding in which registrant has no opportunity to be heard on this question and it is the practice to resolve doubt under Section 2(d) with the registrant." In re Mayco Mfg., 192 USPQ 573, 576 (TTAB 1976).

Decision: The examining attorney's refusal is affirmed.